



IPW

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q72585

Charles Frederick James BARNES

Appln. No.: 10/690,569

Group Art Unit: 2651

Confirmation No.: 5982

Examiner: Dismery E. MERCEDES

Filed: October 23, 2003

For: INFORMATION STORAGE SYSTEMS

RESPONSE TO ELECTION OF SPECIES WITH TRAVERSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner has identified the application as containing claims directed to 12 distinct species. The Examiner has required the Applicant to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted. The Examiner believes there are no generic claims. Applicant has been advised that a response to this requirement shall include an identification of the species that is elected and a listing of all claims readable thereon.

In response to the Examiner's requirement, Applicant elects, with traverse, Species II, Figure(s) 10-11c for examination on which claims 1 to 37, 42, 43 and 50-54 are readable.

Applicants respectfully traverse the Examiner's restriction requirement and request full examination of all the pending claims on the merits.

One criteria for a proper election of species requirement is that there must be a serious burden on the Examiner if restriction is not required. See MPEP §803. Further, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent and distinct inventions"

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(MPEP §803). Additionally, as stated in MPEP 806.04(a), "37 C.F.R. §1.141 provides that a reasonable number of species may still be claimed in one application."

Moreover, Applicant notes that claims 38-41 and 44-49 are the only claims of currently pending claims 1-54 that are not identified with Species II. Applicant submits that the Examiner will, no doubt, search the same art sources when examining claims 38-41 and 44-49. Therefore, Applicant submits that the examination of pending claims 1-54 together would not impose a serious burden on the Examiner.

Restrictions are not to be made solely because it is possible, but rather for the efficient and timely handling of an application in accordance with the principle of compact prosecution. It is respectfully submitted that the present requirement for election is not in accordance with the principle of compact prosecution.

Additionally, Applicant submits that if any of the elected claims are found to be allowable, claims dependent therefrom should similarly be considered allowable in the same application.

Applicant reserves the right to file a Divisional Application directed to non-elected claims 38-41 and 44-49.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

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